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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,702	06/18/2001	Gilles Chriqui	Q64917	8603

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/881,702

Applicant(s)

CHRIQUI, GILLES

Examiner

Callie E. Shosho

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 1/8/02. The following action is non-final in light of the new grounds of rejection as set forth in paragraphs 9-10 below.

**Priority**

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 6/19/00.

Previously, examiner stated that the applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b). In response, on page 4 of the amendment filed 1/8/03 applicants state that the certified copy of the French application was filed on 8/15/01 and submit evidence in the form of a mailing receipt. However, the certified copy of the priority document has not been found by the examiner in the present application.

**Claim Rejections - 35 USC § 103**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. (U.S. 5,149,732) in view of Keogh (U.S. 4,407,992) and either Nitta et al. (U.S. 6,075,086) or Abe et al. (U.S. 5,296,273).

The rejection is adequately set forth in paragraph 9 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. in view of Keogh and either Nitta et al. or Abe et al. as applied to claims 1-5 and 8 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The rejection is adequately set forth in paragraph 10 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

6. Claims 1-3, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001.

The rejection is adequately set forth in paragraph 14 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, and 8 above, and further in view of Coaker et al. (U.S. 5,036,121).

The rejection is adequately set forth in paragraph 15 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, and 8 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The rejection is adequately set forth in paragraph 16 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

9. Claims 9-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001.

GB 2,016,016 discloses extrudable, curable, flame retardant, oil resistant composition comprising 10-50 parts chlorinated polyolefin, 70-300 parts hydrated alumina, 10-50 parts antimony oxide, and silane coupling agent, which as seen from the examples, is present in an amount of 1-4 parts. The ingredients are mixed in mixer while heating them to temperature of 120 °C followed by transforming the mixture, and extruding (page 1, lines 10-11, page 1, line 57- page 2, line 1, page 2, lines 31-41, and page 3, lines 1-3, 27-29, and 55-64).

The difference between GB 2,016,016 and the present claimed invention is the requirement in the claims of (a) aminosilane and (b) order in which ingredients are mixed.

With respect to difference (a), EP 721001 discloses composition comprising chlorinated polyolefin and aminosilane in order to produce composition with long pot life and excellent heat resistance after curing (page 2, lines 9-11, page 3, lines 3-8 and 32-35, and col.4, lines 29-33). Given that the disclosure of GB 2,016,016 in view of EP 721001 discloses composition identical to that presently claimed, it is clear that such composition would intrinsically be resistant to oil as presently claimed.

In light of the motivation for using aminosilane disclosed by EP 721001 as described above, it therefore would have been obvious to one of ordinary skill in the art to use aminosilane in the composition of GB 2,016,016 in order to produce composition with long pot life and excellent heat resistance after curing, and thereby arrive at the claimed invention.

With respect to difference (b), it is noted that neither GB 2,016,016 nor EP 721001 disclose mixing chlorinated polyolefin, mineral filler, and treatment agent first followed by adding aminosilane.

However, although the manner in which GB 2,016,016 in view of EP 721001 introduces the ingredients into the composition is different than that presently claimed, given that the end result is the same, i.e. composition comprising chlorinated polyolefin, treated filler, and aminosilane, and absent evidence of criticality regarding the order of introduction of the ingredients into the composition, it therefore would have been obvious to one of ordinary skill in the art (i) to mix the ingredients in any order, including that presently claimed, and (ii) that the final composition of GB 2,016,016 in view of EP 721001 is the same as presently claimed, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

10. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 9-10 and 13 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The difference between GB 2,016,016 in view of EP 721001 and the present claimed invention is the requirement in the claims of auxiliary polymer.

Schombourg et al., which is drawn to composition comprising chlorinated polyolefin and aminosilane, disclose using porous polymer as carrier for the silane so that it is much easier to add the silane to the polymer during mixture (col.5, lines 45-52).

In light of the motivation for using auxiliary polymer disclosed by Schombourg et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the composition of GB 2,016,016 in order to produce a composition which easily mixed, and thereby arrive at the claimed invention.

#### **Response to Arguments**

11. Applicant's arguments filed 1/8/03 have been fully considered but they are not persuasive.

Specifically, applicant argues that:

(a) None of the cited references discloses particular combination of elements as presently claimed, i.e. chlorinated polyolefin, mineral filler, and filler agent, and that none of the cited references discloses the use of chlorinated polyolefin and mineral filler in the presently claimed proportions.

(b) There is no disclosure in any of the cited references of method for preparing composition as presently claimed.

With respect to argument (a), it is noted that present claim 1 requires the use of 100 parts chlorinated polyolefin and 100-250 parts mineral filler, while claim 3, which depends on claim 1,

requires the use of 0.5 –5 parts treating agent for filler, and claim 8, which depends on claim 1, requires that the ratio of filler to chlorinated polyolefin is 1.4-1.7.

With respect to Igarashi et al., it is noted that this reference discloses composition comprising 100 parts chlorinated polyolefin and 30-300 parts mineral filler, which overlaps the amounts in present claim 1. It is calculated that the ratio of filler to chlorinated polyolefin is 0.3 to 3, which clearly overlaps the ratio of present claim 8.

It is agreed that there is no disclosure in Igarashi et al. of treating agent for filler which is why Igarashi et al. is used in combination with either Nitta et al. or Abe et al. which disclose treating filler with silane in order to improve mixing property, molding properties, self tapping strength, and weld strength (Nitta et al.), or alternatively, to increase dispersability of the filler (Abe et al.). Although there is no disclosure in either Nitta et al. or Abe et al. of the amount of treating agent used, it would have been obvious to one of ordinary skill in the art, absent evidence to the contrary, to choose amount of treating agent, including that presently claimed, in order to produce composition with improve mixing property, molding properties, self tapping strength, and weld strength, or alternatively, suitable dispersability, and thereby arrive at the claimed invention.

With respect to GB 2,016,016, it is noted that this reference discloses composition comprising 10-50 parts chlorinated polyolefin (per 100 part vinyl acetate-ethylene copolymer) and 70-300 mineral filler, which is treated with 1-4 parts silane coupling agent. Thus, for 100 parts chlorinated polyolefin, the composition would possess 140-600 parts mineral filler and 2-8 parts silane coupling agent, which overlaps the amounts in present claims 1 and 5. It is calculated



that the ratio of filler to chlorinated polyolefin is 1.4-6, which clearly overlaps the ratio of present claim 8.

It is agreed that there is no disclosure in GB 2,016,016 of aminosilane. However, this is why GB 2,016,016 is used in combination with EP 721001, which discloses composition comprising chlorinated polyolefin and aminosilane in order to produce composition with long pot life and excellent heat resistance after curing.

While EP 721001 do not disclose composition comprising chlorinated polyolefin, mineral filler, and treating agent in proportions presently claimed, note that EP 721001 is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of aminosilane in composition comprising chlorinated polyolefin, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

With respect to argument (b), it is noted that there is no disclosure in GB 2,016,016 or EP 721001 of mixing chlorinated polyolefin, filler, and treating agent first, followed by addition of aminosilane.

However, although the manner in which GB 2,016,016 in view of EP 721001 introduces the ingredients into the composition is different than that presently claimed, given that the end

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result is the same, i.e. composition comprising chlorinated polyolefin, treated filler, and aminosilane, and absent evidence of criticality regarding the order of introduction of the ingredients into the composition, it therefore would have been obvious to one of ordinary skill in the art (i) to mix the ingredients in any order, including that presently claimed, and (ii) that the final composition of GB 2,016,016 in view of EP 721001 is the same as presently claimed, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

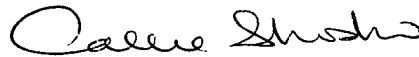
On page 10 of the amendment filed 1/8/03, applicant argues that the order in which the ingredients are mixed is important given that the claimed order allows the aminosilane to react directly with the chlorinated polyolefin without being deactivated in any way by the filler so as to be grafted to the chlorinated polyolefin without giving off hydrochloric acid. However, applicant has not provided any evidence to support this position. Further, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments set forth in the amendment regarding the method for preparing the presently claimed composition must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Examiner  
Art Unit 1714

CS  
March 19, 2003